



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/287,631	04/07/99	EBY	J 03063.0396-0

IM52/1010  
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EXAMINER

KUHNS, A

ART UNIT PAPER NUMBER

1732

*38*

DATE MAILED: 10/10/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application N

09/28/631

Applicant(s)

EBY ET AL.

Examiner

KUHNS

Group Art Unit

1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on JULY 26, 2001 BEST AVAILABLE COPY
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 25-26, 33-46 AND 48-52 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 25-26, 33-46 AND 48-52 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 31, 35, 37
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. In the Information Disclosure Statement filed June 20, 2001 an article by Andrew Hunter is listed, but no copy has been located in the file. Please provide a copy of this article in the response to this Office action.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-26, 33-46 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. (4,214,028). Shortway et al. disclose the basic claimed method of making a surface covering having multiple layers including (1) chemically embossing a first layer, and (2) mechanically embossing at least a portion of a second layer, wherein the second layer is a wear layer. Shortway et al. appear not to explicitly teach the aspect that the chemically embossed portion of the first layer has a depth greater than any embossed portion of the second layer, but forming embossed layers having such relative embossment depths would have been obvious to one of ordinary skill in the art in order to form a surface covering having a cross section like that illustrated in Shortway et al. in Figure 11.

Shortway et al. suggest the curing of a uniform viscosity wear layer, as in claim 51, at column 19, lines 34-68 for embodiments in which flat, dead or dull surface finishes are not deemed desirable. Shortway et al. teach applying the wear layer before chemical embossing, as in claim 33, at column 20, lines 15-36, and the first layer being a foam layer, as in claim 34.

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Shortway et al. teach embossing depths within the ranges of claims 35-36 and 43-44 at column 18, lines 54-61 and do not teach or suggest crushing of foam cells, as in claims 37 and 45, or the mechanical embossing of the foam layer, as in claims 38 and 46. Shortway et al. teach or suggest expanding the foam, as in claim 25, and mechanically embossing a layer in a softened state, as in claims 26, 40 and 42. Shortway et al. teach the aspect of using a retarder or an inhibitor, as in claim 39 and suggest the temperature manipulation of claim 41 by describing each type of embossing as separate steps in the process.

4. Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. as applied to claims 25-26, 33-46 and 51-52 above, and further in view of McCann et al. (4,100,318). McCann et al. teach, at column 4, lines 13-16 the aspect of conducting mechanical embossment subsequent to chemical embossing. It would have been obvious to one of ordinary skill in the art to incorporate this aspect into the method of Shortway et al. since either embossing order has been shown to produce satisfactory surface coverings. The prior comments concerning claim 51 are also considered to be applicable to claim 49 and Shortway et al. do not teach the presence of reactive compounds which would lead to chemical embossing of the wear layer, as in claim 50.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30. The examiner can also be reached on alternate .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Allan R. Kuhns*  
**ALLAN R. KUHN**  
**PRIMARY EXAMINER** AU 1732  
10-9-01